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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,780	10/20/2000	Arturo A. Rodriguez	A-6694	8562

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,780	RODRIGUEZ ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *57-59,61,63-65,92-98 and 101-103* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *57-59,61,63-65,92-98 and 101-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 September 2005 has been entered.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,987) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 57-59, 61, 63-65, 92-98, and 101-103 of this application. In particular, while the earlier filling discloses the ability to provide supplemental content, the disclosure fails to provide adequate support as to the particular method by which the content is stored, transmitted, and locally processed for presentation as claimed.

3. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,520, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-2) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application wherein sequential data supplements are provided responsive to user in a manner that is

synchronized with the video presentation does not appear to be disclosed in the parent application. Accordingly, the claims of the instant application shall be examined in view of the filing date of the instant application (19 October 2000).

Response to Arguments

4. Applicant's arguments with respect to claim 101 has been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's assertion such that the references in combination do not teach or disclose that "responsive to receiving the first viewer input, providing a second selectable option ot received the supplementary data stream in the STT, wherein the second selectable option is first provided after receipt of the first user input and as a direct result of receiving the first user input", the examiner respectfully disagrees. The White et al. reference teaches that subsequent to ordering a program that a program appears in a program guide as being available for subsequent access. The Watts et al. reference discloses that the program guide provides information for available programs wherein the user is operable to select an option to display additional content. Given that the "second selectable option" is only provided for available programs as taught by Watts et al. (Col 8, Lines 17-29), the particular "second selectable option" associated with the particular presentation of supplemental content for the newly ordered program cannot occur until "after receipt of the first user input and as a direct result of receiving the first user input" associated with making the program available for viewing. For example, until a viewer orders the movie "Ronin", the particular listing does not appear within the program guide (White et al.: Col 5, Line 59 – Col 6, Line 9).

Accordingly, the "second selectable option" associated with providing supplemental content for the ordered movie "Ronin" appears as a direct result of the user ordering the movie "Ronin" (ex. first user input).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 59, 61, 63, 64, 65, 95, 98, 101, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302) in view of Watts et al. (US Pat No. 6,324,694).

In consideration of claim 101, Figure 1 of the White et al. reference illustrates a system which performs a "method implemented by a television set-top terminal ("STT") [14] (Col 2, Lines 53-62) that is "configured to receive a video program from a remote server" [12]. The

method comprises "storing by the STT a first plurality of streams corresponding to the video program in the remote server" comprising "a second plurality streams . . . including an audio streams, a video stream, and a subtitle streams" corresponding to MPEG encoded video-on-demand programs and "supplementary data streams corresponding to supplementary information . . . that is different than all the streams in the second plurality of streams" corresponding to enhanced content (Col 2, Lines 17-48; US Pat No. 5,906,323 incorporated by reference discloses the particular usage of closed captioning or "subtitles streams"). The aforementioned streams are considered stored by the "STT" [14] in connection with being received and rendered by the terminal [14]. The system subsequently provides a "first selectable option to receive the video program from a plurality of video programs", "receives a first viewer input from a viewer being configured to select the first selectable option", provides a screen corresponding to billing arrangements, and subsequently "communicates with the server by the STT via a first transmission channel to receive the first plurality of streams" in connection with the ordering and delivery of a designated video-on-demand program (Col 4, Lines 12-58). The reference, however, does not particularly disclose the details corresponding to the delivery of the requested video program in connection with the synchronous delivery, storage, and rendering of supplemental content as claimed.

In a related art pertaining to interactive video distribution services, the Watts et al. reference discloses a method for providing subsidiary data or "supplementary data streams corresponding to supplementary information . . . that are different than all the streams in the second plurality of streams" (Col 4, Lines 23-33) synchronous to primary content data corresponding to television or non-television programming content delivered by a remote

server (Abstract; Col 2, Line 64 – Col 3, Line 34). The reference discloses that the system "receives a respective sequential portion of each stream in the first plurality of streams" comprising both the "second" (primary content) and the "supplementary content" (subsidiary data) "substantially simultaneously via a tuner in the STT tuned to the first transmission channel" corresponding to the video program (Col 4, Lines 34-49; Col 5, Lines 21-33). In association with the processing of the "first plurality of streams", the reference discloses that the user is provided with a "second selectable option to receive a supplementary data stream" that is "responsive to receiving the first viewer input" as shall be subsequently addressed in view of the combined references. After "receiving a second viewer input from a viewer responsive to providing the second selectable option", indicating that the "supplementary data stream" has been either accepted or "rejected . . . at the STT" by the user, the system "receives a sequential portion of each "first plurality of streams from the remote server" comprising both the "second" (primary content) and the "supplementary content" (subsidiary data) (Col 8, Lines 17-29). Therefore, responsive to "receiving the second viewer input corresponding to selecting the second selectable option" indicating a desire to utilize the supplemental content, the system "stores the sequential portions of the supplementary data stream and each stream in the second plurality of streams into respective sections of memory in the STT" (ex. [614/616]) and "presents the supplementary data stream and an audio stream and a video stream in the second plurality of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" (Col 3, Line 34 – Col 4, Line 23; Col 10, Line 52 – Col 12, Line 11). Alternatively, responsive to "receiving the second viewer input corresponding to a viewer

input that is different than a viewer input corresponding to selecting the second selectable option" so as to indicate a desire not to utilize the supplemental content, the "supplementary data stream" is rejected by the user and as such will not be utilized during the video presentation. The system subsequently, "stores the sequential portions of each stream in the second plurality of streams into respective sections of memory in the STT" (ex. [616]) and "presents an audio stream and a video stream of the video program in the second plurality of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" in conjunction with the presentation of the video program corresponding to the primary content. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so utilize the supplemental content distribution teachings of Watts et al. to the White et al. video distribution system teachings for the purpose of utilizing an effective method of providing a robust method for provisioning of supplemental program information for television programming (Watts et al.: Col 1, Lines 21-45).

Taken in combination, the references provide a means by which interactive services may be provided during the pausing or stopping of a requested video-on-demand program and other forms of supplemental content associated with video programs may be optionally simultaneously presented during the program. With respect to the limitation such that the "second selectable option" is provided "responsive to receiving the first viewer input. . . . [and] is first provided after receipt of the first user input and as a direct result of receiving the first user input", the limitation is met in view of the combined teachings in a number of ways. The White et al. reference discloses that the selected program does not appear in the

electronic program guide until the program has been selected (Col 5, Lines 66 – Col 6, Line 2). The Watts et al. "second selectable option" is disclosed as being accessible through the electronic program guide (Col 8, Lines 20-26). Accordingly, it would logically follow that if the program does not appear in the program guide until it has been selected by the "first selectable option" then the "second selectable option" would appear "responsive to receiving the first viewer . . . [such that the] second selectable option is first provided after receipt of the first user input and as a direct result of the first user input" in conjunction with the provisioning of supplemental content for the ordered program.

Alternatively, the limitation is met in view of an obvious modification of the combined references. As aforementioned, the White et al. reference after providing the user with the "first option" associated with selecting a video-on-demand presentation provides the user with a screen associated with billing arrangements. The Watts et al. reference discloses that the user may be billed in order to utilize supplemental content (Col 5, Lines 45-55). Accordingly, it would have been obvious to one having ordinary skill in the art in light of the combined references so as to provide the "second selectable option" associated with accepting or rejecting access to the supplemental data responsive to the "responsive to receiving the first viewer . . . wherein the second selectable option is first provided after receipt of the first user input and as a direct result of receiving the fist user input" or at the point of establishing billing arrangements for the purpose of providing the user with a convenient means for establishing the cost of a video-on-demand presentation based upon available selectable billing options.

Claim 59 is rejected wherein "presenting the sequential portions of the supplementary data stream at a plurality of respective time intervals corresponding to respective portions of the video program is a time-synchronized composition of the supplementary data stream and the video program according to time stamp specifications" as defined by the supplemental content (Watts et al.: Col 7, Lines 8-29).

Claim 61 is rejected wherein the "supplementary data stream comprises at least one of. . . video data and audio data" (Watts et al.: Col 3, Line 56 – Col 4, Line 23).

Claim 63 is rejected wherein the "video program comprises a video-on-demand program established over a dedicated network session been the remote server and the STT" (White et al.: Col 3, Line 66 – Col 4, Line 11; Col 4, Line 38 – Col 6, Line 15).

Claim 64 is rejected wherein "at least a portion of the supplementary data stream" and "at least a respective portion of each stream in the first plurality of streams" or that portion corresponding to the video-on-demand presentation are "received substantially simultaneously by the STT from a single tuned transmission channel via the tuner in the STT" (White: Col 3, Line 66 – Col 4, Line 11; Watts: Col 3, Lines 22-33; Col 4, Lines 49; Col 5, Lines 29-33).

Claim 65 is rejected wherein "at least a portion of the supplementary data stream and the at least a respective portion of each stream in the first plurality of streams" or portions corresponding to the video-on-demand presentation are "presented by the STT as a television signal" (White et al.: Col 3, Lines 9-12; Watts et al.: Col 3, Lines 17-21).

In consideration of claim 95, the Watts et al. reference is not limiting such that the same portion of supplemental content cannot be reused throughout the presentation for the purpose

of advantageously providing the user with several opportunities to access relevant supplemental content. For example, Robert DeNiro stars in and appears in several scenes in the movie "Ronin" (White: Figure 4). Presuming that the supplemental content to be inserted was biographical information regarding Robert DeNiro (Watts et al.: Col 4, Line 28-31) to be inserted during certain points within the presentation, then "at least one portion of the supplemental stream of data" (ex. biographical information) would be "associated to and presented during a first interval" (ex. scene 1) and a "second interval of the presentation of the video program" (ex. scene 2) in order to advantageously provide the user with an additional opportunity to access the biographical information in case they did not notice that the information was available the first time it was presented.

In consideration of claim 96, the "supplementary data stream is graphical data that is specified by screen locations" (Watts et al.: Col 4, Lines 4-16 and 23-33) and "an active time interval in relation to the presentation time portions of the video program" (Watts et al.: Col 5, Lines 21-33; Col 7, Lines 8-15).

Claim 98 is rejected wherein the "supplemental stream of data is audio data is mixed with the main audio" (Watts et al.: Col 4, Lines 16-23).

Claim 103 is rejected wherein the "video program" or video-on-demand movie associated with the "first plurality of streams corresponding to an entirety of the stored video program" implicitly "corresponds to a single consumable version of the video program in the remote server . . . corresponding to the released form of the video program" such as the movie "Ronin" (White et al.: Figure 4).

8. Claims 57, 58, 94, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), and in further view of Abecassis (US Pat No. 6,408,128).

In consideration of claim 57, the Watts et al. reference discloses that the supplemental content data can be any form of multimedia data designed to supplement the primary video program (Col 4, Lines 24-27). The reference, however, does not explicitly disclose that the "supplementary data stream comprises on-screen comments . . . being one of director comments, producer comments, actor comments, and comments from another viewer". The Abecassis provides a showing of fact that it is known in the art for a "supplementary stream of data" to "comprise on-screen comments, the on-screen comments being one of director comments, producer comments, actor comments, and comments from another viewer" (Abecassis: Col 51, Line 61 – Col 52, Line 12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time so as to utilize "on-screen comments" as claimed as a form of supplementary data for the purpose of advantageously utilizing other known forms of supplemental data including director commentaries in order to enhance a viewer's movie watching experience.

In consideration of claim 58, as aforementioned, the Watts et al. reference suggests that any type or program related timing of supplemental content may be utilized. While the Watts et al. reference discloses "presenting at least a portion of the supplementary data stream during at least one time interval" during the "video presentation", it is unclear if the particular supplemental content necessarily "corresponds to the appearance time of a visual object contained in the video program". Abecassis provides a showing of fact that it is known

in the art of video distribution to present supplemental content "during at least one time interval correspond to the appearance time of a visual object contained in the video program" (Col 51, Line 61 – Col 52, Line 20). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly present supplemental content "during at least one time interval correspond to the appearance time of a visual object contained in the video program" for the purpose of advantageously utilizing supplemental content to explain a particular observable object or scene which supplemental content is available.

In consideration of claim 94, the Watts et al. reference discloses that the system may use a variety of means to identify when to present supplementary content during a video presentation. The reference, however, does not explicitly identify that the video program comprises "video chapters". Abecassis provides a showing of fact that video-on-demand presentations comprise "video chapters" (Col 63, Lines 29-42). Therefore, it would have been obvious, if not inherent to the video-on-demand presentation, for one having ordinary skill in the art at the time the invention to utilize "video chapters" in a video-on-demand presentation for the purpose of utilizing a logical organization to a narrative which facilitates the quick selection of particular scenes. Subsequently, the Watts et al. reference implicitly "presents the sequential portions of the supplemental stream of data at a plurality of respective time intervals in relation to a starting point in the video program, the starting point being a video chapter" given that any supplemental content presented during a video program comprising "video chapters" is somehow being presented in relationship to a staring point of a "video chapter" (ex. before, during, or after).

In consideration of claim 97, as aforementioned, the "supplemental data stream is graphical data" (Watts et al.: Col 4, Lines 4-16 and 23-33) , however the Watts et al. reference does not explicitly set forth that the particular supplemental content is necessarily utilized to "point to inconspicuous parts of the video presentation". Abecassis provides a showing of fact that video-on-demand presentations comprise "inconspicuous parts" and that supplemental information may be utilized to "point out" those parts. For example, supplemental content is known to be used in connection with explaining how a magic trick was performed (Col 52, Lines 41-48). Accordingly, it would have been obvious to one having ordinary skill in the art to illustrate the "inconspicuous parts" in conjunction with supplemental data explaining how a magic trick was accomplished for the purpose of educating viewers as to how they were tricked and/or how they could trick others in a similar fashion.

9. Claims 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), and in further view of Adams (US Pat No. 6,378,130).

In consideration of claims 92 and 93, it is unclear if the combined references necessarily encrypt the "supplementary data stream" as well as the "audio, and video data" associated with the video-on-demand program wherein the information is "transmitted over the same transmission channel" or "radio-frequency channel with a specified center frequency wherein data carried in said transmission channel is modulated via quadrature amplitude modulation (QAM)".

The Adams reference discloses a VOD delivery architecture wherein multiplexed signals (MPEG) associated with the video presentation including HTML content are distributed via a "single tuned transmission channel" and are "received substantially simultaneously" via the "tuner in the STT" [41] (Adams: Col 10, Line 40 – Col 11, Line 19). The "supplemental stream of data, audio and video are encrypted and transmitted over the same transmission channel" (Adams: Col 3, Lines 31-38) wherein the "transmission channel is a radio-frequency channel with a specified center frequency, wherein data carried in said transmission channel is modulated via quadrature amplitude modulation (QAM) (Adams: Figure 5; Col 10, Line 40 – Col 11, Line 19).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize "single tuned transmission channel" as taught by Adams for the purpose of utilizing a VOD delivery architecture that is much less complex than prior media delivery systems providing the same services and provides greater flexibility with respect to the system capacity may be changed (Adams: Col 7, Lines 8-16).

10. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), and in further view of Dunn et al. (US Pat No. 5,861,906).

In consideration of claim 102, the combined reference disclose "configuring . . . initial transmission to the STT of the video program and the supplementary data stream via a first transmission channel", "receiving the initial transmission of the video program and the supplemental data stream in the STT during" the video-on-demand presentation "via a tuner in the STT tuned to the first transmission channel" and "presenting a respective portion of the

initial transmission of the video program and the supplementary data stream simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" (Watts et al.: Col 3, Lines 56-58; Col 4, Lines 34-49; Col 5, Lines 21-33). The references, however, are silent as to the particular establishment of "configuring a rental viewing period" associated with a video-on-demand presentation. The Dunn et al. reference discloses that it is known in the art to "configure a rental viewing period" for video-on-demand presentations (Col 12, Lines 1-17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to advantageously provide the cable provider with the ability to flexibly define rental periods as they wish.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614

SEB
December 13, 2005